

**PATENT APPLICATION
DOCKET NO. 10008202-1**

**IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE**

INVENTOR(S) :	Shell Simpson	GROUP ART UNIT:	2155
SERIAL NO.:	10/059,083	EXAMINER:	Eng, David Y
FILED:	01/28/2002	CONFIRMATION NO:	3244
SUBJECT:	PRINTING SYSTEM WITH NOTIFICATION FUNCTION		

**COMMISSIONER FOR PATENTS
ALEXANDRIA, VA 22313-1450**

SIR:

APPELLANTS'/APPLICANTS' OPENING BRIEF ON APPEAL

1. REAL PARTY IN INTEREST.

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holding, LLC.

2. RELATED APPEALS AND INTERFERENCES.

There are no other appeals or interferences known to Appellants,

Appellants' legal representative or the Assignee which will affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

3. STATUS OF CLAIMS.

Claims 1-24 are pending but stand rejected. The rejections for all pending claims are appealed.

4. STATUS OF AMENDMENTS.

No amendments have been filed after the final action was entered. All previous amendments have been entered.

5. SUMMARY OF CLAIMED SUBJECT MATTER.

Claim 1 recites a method of transmitting a message. The method includes determining if a device encounters an event while processing a job. *See, e.g.*, step 1106 in Fig. 11 and page 15, lines 21-25. It is determined if the job meets a pre-determined criterion. *See, e.g.*, step 1108 in Fig. 11 and page 15, lines 21-25. A message is transmitted to a remote destination when each of a set of pre-determined conditions exist. *See, e.g.*, step 1110 in Fig. 11, and Page 15, lines 21-25. Those conditions include (a) a determination that the device encountered the event while processing the job; and (b) a determination that the job met the pre-determined criterion. *See, e.g.*, steps 1106 and 1108 in Fig. 11 and page 15, lines 21-25.

Claim 10 recites a method of transmitting a message. The method includes receiving input that specifies at least one print job criterion and an e-mail address. *See, e.g.*, step 1102 in Fig. 11 and page 15, lines 18-19. A print job is submitted to a printer for processing. *See, e.g.*, step 1104 in Fig. 11 and page 15, lines 19-20. It is determined if a device encounters an event while processing a job, and it is determined if the job meets the print job criterion. *See, e.g.*, steps 1106 and 1108 in Fig. 11 and page 15, lines 21-25. If it is determined that the print job meets the at least one print job criterion and that the printer encountered

an event while processing the print job, an e-mail message is transmitted to the e-mail address. *See, e.g.*, steps 1106, 1108, and 1110 in Fig. 11 and page 15, lines 21-25.

Claim 15 recites a computer readable medium embodying a program of instructions for causing a computer to perform method steps. The method steps include receiving a request from a user to print a document. *See, e.g.*, step 816 in Fig. 8B and page 10, lines 27-28. In response to the request, (a) the document is accessed to determine if the document has at least one characteristic (*See, e.g.*, step 910 in Fig. 9B and page 12, lines 15-16), (b) a print job is submitted that describes the document to a printer (*See, e.g.*, Fig. 11, step 1104 and page 15, lines 18-25), and (c) it is determined if the printer encounters an event while processing the print job (*See, e.g.*, steps 1014 and 1016 in Fig. 10 and page 13, lines 6-8). If it is determined that the print document has the at least one characteristic and that the printer has encountered the event while processing the job, a device is commanded to transmit a message to a pre-determined address. *See, e.g.*, steps 1016 and 1020 in Fig. 10 and page 13, lines 9-12.

Claim 19 recites a computing system. The computing system includes means for receiving input from a user that specifies at least one print job criterion. *See, e.g.*, PC 104 in Fig. 1; printer 106 in Fig. 5; page 6, lines 15-16; step 1102 of Fig. 11; and page 15, lines 18-20. The system includes means for receiving a request from the user to submit a print job to a printer. *See, e.g.*, components 502, 504, and 506 of printer 106 in Fig. 5; page 6, lines 10-17, step 806 of Fig. 8A, and page 10, lines 13-15. Also included are means for responding to the request by submitting the print job to the printer and means for determining if the print job meets the at least one print job criterion. *See, e.g.*, components 502, 504, 506, and 508 of printer 106 in Fig. 5; page 6, lines 10-17; step 814 in Fig. 8B, page 10, lines 25-26; step 902 in Fig. 9A and page Fig. 11, lines 19-21. The system includes means for determining if the printer encounters an event. *See, e.g.*, components 502, 504, 506, and 508 of printer 106 in Fig. 5; page 6, lines 10-17, steps 1014 and 1016 of Fig. 10, lines 6-8. The system also includes

means for transmitting a message to an address upon a determination that the print job meets the at least one print job criterion and that the printer has encountered the event. *See, e.g.*, components 502, 504, 506, and 508 of printer 106 in Fig. 5; page 6, lines 10-17 and step 1020 in Fig. 10, page 13, lines 9-11.

6. GROUNDS FOR REJECTION TO BE REVIEWED.

A. Claims 1-8, 10-11, 13-17, and 19-24 stand rejected under 35 U.S.C. §102 as being anticipated by USPN 6,975,419 issued to Staas.

B. Claim 9 stands rejected under 35 U.S.C. §103 as being unpatentable over USPN 6,975,419 issued to Staas in view of USPN 6,978,313 issued to Pietrowicz.

C. Claims 12 and 18 stand rejected under 35 U.S.C. §103 as being unpatentable over USPN 6,975,419 issued to Staas in view of USPN 5,751,961 issued to Smyk.

7. ARGUMENT.

A. Ground For Rejection A – Claims 1-8, 10-11, 13-17, and 19-24 stand rejected under 35 U.S.C. §102 as being unpatentable over USPN 6,975,419 issued to Staas.

Claim 1 is directed to a method of transmitting a message and recites the following elements:

- a) determining if a device encounters an event while processing a job;
- b) determining if the job meets a pre-determined criterion; and
- c) transmitting a message to a remote destination when each of a set of pre-determined conditions exist, the pre-determined conditions include:
 - a. determination that the device encountered the event while processing the job; and

- b. a determination that the job met the pre-determined criterion.

Rejecting Claim 1, the Examiner relies on Staas, Abstract, Figs. 1, 3B, and 6A. Staas discusses a system designed for e-mail printing. In particular Staas discusses system in which a printer is associated with an e-mail address. Email messages received at that address are converted into print jobs to be printed by that printer. *See, e.g.,* Staas, Abstract, Fig. 1, and col. 2, lines 9-38.

Staas, Figs. 3A and 3B illustrate flow diagrams charting a process for printing an email message. In step 326, print jobs are created for a received email and attachment thereto. For each of those print jobs, a rendering application is identified in step 329. A rendering application is an application that renders the print job into a printer ready format. Staas, col. 6, lines 4-17. Once rendered into a printer ready format, it is determined if there are any errors in step 339. Staas explains that an error results if the rendering application is not capable of fulfilling a particular print option of a print job or simply not able to perform the rendering function at all. Staas, col. 11, lines 50-64. Upon detection of an error, a message is returned to the sender of the email in step 343.

In rejecting Claim 1, the Examiner equates step 329 with both the act of determining if a device encounters an event while processing a job and the act of determining if the job meets a pre-determined criterion as recited in Claim 1. Staas' step 339 is simply a determination of whether a rendering application encountered a problem in rendering a print job. With respect to Claim 1, step 339 is at best a determination as to whether a device has encountered an event – that event being an error with respect to the rendering application. Staas's step 339 has nothing to do with determining if the job (the email attachment thereto, or resulting print job) meets a predetermined criterion.

Therefore, the message returned in Staas' step 343 is not transmitted when each of a set of predetermined conditions exist where those conditions include (a) a determination that the device encountered the event while processing the job and (b) a determination that the job met the pre-determined criterion.

Staas Figs. 6A and 6B illustrate flow diagrams charting a process for retrieving and printing a document referenced in an e-mail print request. Staas, col. 15, lines 19-37. After receiving an email request in step 430, it is determined if the email is of proper format in step 446. If not, a message is returned to the sender of the email request in step 449. If the email request is properly formatted, it is determined if a file referenced in the email request can be found in step 456. If not, a message is returned to the sender of the email request. If the file can be found, it is determined if the file is to be forwarded on to a recipient other than the sender of the email request. If so, an email containing the file is forwarded in steps 466, 473, and 476. If not, an email containing the file is returned to the sender of the email request in steps 469, 473, and 476.

In rejecting Claim 1, the Examiner equates each of steps 446, 456, and 463 with both the act of determining if a device encounters an event while processing a job and the act of determining if the job meets a pre-determined criterion as recited in Claim 1. Each of Staas' steps 446 and 463 is simply a determination as to a format of a request email – either a proper format in step 446 or a document forward format in step 463.

With respect to Claim 1, steps 446 and 463 are at best determinations as to whether an email request meets a predetermined criterion (proper format or document forward indication). Staas's steps 446 and 463 have nothing to do with determining if a device has encountered an event while processing the email request. Therefore, neither the message returned in Staas' step 449 nor the email forwarded in steps 466, 473, and 476 are transmitted when each of a set of predetermined conditions exist where those conditions include (a) a determination that the device encountered the event while processing the job and (b) a determination that the job met the pre-determined criterion.

Furthermore Staas step 456 is simply a determination of whether a file referenced in an email request can be found. With respect to Claim 1, step 456 is at best a determination as to whether a device has encountered an event – that event being not being able to find a file. Staas's step 339 has nothing to do with determining if the file or email request meets a predetermined criterion. Therefore, the message returned in Staas' step 459 is not transmitted when each

of a set of predetermined conditions exist where those conditions include (a) a determination that the device encountered the event while processing the job and (b) a determination that the job met the pre-determined criterion.

As such, not one of Staas' messages returned in steps 343, 449, 459, or 466 is transmitted to a remote destination when each of a set of pre-determined conditions exist where those pre-determined conditions include (a) a determination that the device encountered the event while processing the job and (b) a determination that the job met the pre-determined criterion. Instead only one condition needs to be met before transmitting any one of Staas' messages.

Consequently, Staas fails to teach or suggest a method that includes transmitting a message to a remote destination when each of a set of pre-determined conditions exist, where the pre-determined conditions include: a determination that the device encountered the event while processing the job; and a determination that the job met the pre-determined criterion.

For at least these reasons, Claim 1 is patentable over Staas as are Claims 2-9 due at least in part to their dependence from Claim 1.

Claim 10 is directed to a method of transmitting a message and recites the following elements:

- a) receiving input that specifies at least one print job criterion and an e-mail address;
- b) submitting a print job to a printer for processing;
- c) determining if a device encounters an event while processing a job;
- d) determining if the job meets the pre-determined criterion; and
- e) if it is determined that the print job meets the at least one print job criterion and that the printer encountered an event while processing the print job, then transmitting an e-mail message to the e-mail address.

The Examiner asserts that Staas, col. 5, lines 39-54 teaches receiving input that specifies at least one print job criterion and an e-mail address. That passage is reproduced below.

Once the user knows the printer alias 199a associated with the printer 136, the user then creates an email message with the email system 183 in the mobile device 153 and attaches the document 203 to be printed to the email message. The user then enters the printer alias 199a as the destination address for the email message and then transmits the email message to the printer 136. The email message with the attached document 203 then is transmitted from the mobile device 153 in a wireless connection to the mobile network 106. Upon detecting the destination address of the email message, the mobile network 106 then provides the email message to the network 103 through the network gateway 119. The network 103 then routes the same email message to the email server 126, and the gateway 193 in the email server 126 routes the email message to the automated print agent 166 through the local area network 109.

Staas, col. 5, lines 39-54.

The cited passage describes a user sending an email with an attached document to an email address for a printer. That message is then routed to an automated print agent for the printer. Nothing in this passage teaches or suggests the receipt of input that includes both an e-mail address and a print job criterion. .

Furthermore, as clarified above with respect to Claim 1, Staas simply does not teach or suggest (1) determining if a device encounters an event while processing a job, (2) determining if the job meets the pre-determined criterion, and then (3) sending of an e-mail message to the e-mail address (*the same e-mail address received in step a*) if it is determined that the print job meets the at least one print job criterion and that the printer encountered an event while processing the print job.

For at least these reasons, Claim 10 is patentable over Staas as are Claims 11-14 due at least in part to their dependence from Claim 10.

Claim 15 is directed to a computer readable medium embodying a program of instructions for causing a computer to perform the followings:

- (a) receiving a request from a user to print a document;
- (b) in response to the request, performing the following substeps:
 - (i) accessing the document to determine if the document has at least one characteristic;
 - (ii) submitting a print job that describes the document to a printer;
 - (iii) determining if the printer encounters an event while processing the print job; and
 - (iv) if it is determined that the print document has the at least one characteristic and that the printer has encountered the event while processing the job, then commanding a device to transmit a message to a pre-determined address.

As clarified above with respect to Claims 1 and 10, Staas simply does not teach or suggest if it is determined that the print document has the at least one characteristic and that the printer has encountered the event while processing the job, then commanding a device to transmit a message to a pre-determined address.

For at least these reasons, Claim 15 is patentable over Staas as are Claims 16-18 due at least in part to their dependence from Claim 15.

Claim 19 is directed to a computing system that includes the following elements:

- a) means for receiving input from a user that specifies at least one print job criterion;
- b) means for receiving a request from the user to submit a print job to a printer;

- c) means for responding to the request by submitting the print job to the printer;
- d) means for determining if the print job meets the criterion;
- e) means for determining if the printer encounters an event; and
- f) means for transmitting a message to an address upon a determination that the print job meets the criterion and that the printer has encountered the event.

As clarified above with respect to Claim 1, Staas simply does not teach or suggest means for transmitting a message to an address upon a determination that the print job meets the criterion and that the printer has encountered the event.

For at least these reasons, Claim 19 is patentable over Staas as are Claims 20-24 due at least in part to their dependence from Claim 15.

C. Claims 12 and 18 stand rejected under 35 U.S.C. §103 as being unpatentable over USPN 6,975,419 issued to Staas in view of USPN 5,751,961 issued to Smyk.

B. Ground For Rejection B – Claim 9 stands rejected under 35 U.S.C. §103 as being unpatentable over USPN 6,975,419 issued to Staas in view of USPN 6,978,313 issued to Pietrowicz.

Claim 9 depends from Claim 1 and includes all the limitations of that base claim. For at least the same reasons Claim 1 is patentable, so is Claim 9.

C. Ground For Rejection C – Claims 12 and 18 stand rejected under 35 U.S.C. §103 as being unpatentable over USPN 6,975,419 issued to Staas in view of USPN 5,751,961 issued to Smyk.

Claims 12 and 18 depend from Claims 10 and 15 respectively. For at least the same reasons Claims 11 and 15 are patentable, so are Claims 12 and 18.

For the reasons set forth above, Claims 1-24 are patentable over the cited references and are in condition for allowance.

Respectfully submitted,
Shell S. Simpson

By Jack H. McKinney/
Jack H. McKinney
Reg. No. 45,685

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APPENDIX OF CLAIMS INVOLVED IN THE APPEAL

1. (previously presented) A method of transmitting a message, the method comprising:
determining if a device encounters an event while processing a job;
determining if the job meets a pre-determined criterion; and
transmitting a message to a remote destination when each of a set of pre-determined conditions exist, the pre-determined conditions include:
a determination that the device encountered the event while processing the job; and
a determination that the job met the pre-determined criterion.
2. (original) The method of claim 1, wherein the device is a printer and the job is a print job.
3. (previously presented) The method of claim 2, wherein determining if a device encounters an event comprises determining if a device encounters a job failure.
4. (previously presented) The method of claim 2, wherein determining if a device encounters an event comprises determining if a device encounters a successful completion of the print job.
5. (previously presented) The method of claim 2, wherein determining if the job meets a pre-determined criterion comprises determining if the print job directs the printer to print at least a threshold number of pages.
6. (previously presented) The method of claim 2, wherein transmitting the message comprises transmitting a message that indicates that the event has occurred.

7. (original) The method of claim 2, furthering comprising:
receiving input from a user that specifies the print job criterion and the location of the remote destination; and
in response to a request received from the user, submitting the print job to the printer.

8. (previously presented) The method of claim 7, wherein transmitting the message comprises transmitting an e-mail message.

9. (previously presented) The method of claim 7, wherein transmitting the message comprises transmitting the message to the remote destination in a manner that results in the user being paged.

10. (previously presented) A method of transmitting a message, comprising:

- (a) receiving input that specifies at least one print job criterion and an e-mail address;
- (b) submitting a print job to a printer for processing;
- (c) determining if a device encounters an event while processing a job;
- (d) determining if the job meets the print job criterion; and
- (e) if it is determined that the print job meets the at least one print job criterion and that the printer encountered an event while processing the print job, then transmitting an e-mail message to the e-mail address.

11. (previously presented) The method of claim 10, wherein transmitting comprises transmitting an e-mail message that indicates that the printer has encountered the event.

12. (previously presented) The method of claim 10, wherein transmitting comprises transmitting an e-mail message that includes a selectable hyperlink to a Web page that provides information regarding the event.

13. (previously presented) The method of claim 10, wherein determining if the device encounters an event comprises determining if the device encounters a job failure.

14. (previously presented) The method of claim 10, wherein determining if the device encounters an event comprises determining if the device encounters a successful completion of the job.

15. (original) A computer readable medium embodying a program of instructions for causing a computer to perform method steps, the method steps comprising:

- (a) receiving a request from a user to print a document;
- (b) in response to the request, performing the following substeps:
 - (i) accessing the document to determine if the document has at least one characteristic;
 - (ii) submitting a print job that describes the document to a printer;
 - (iii) determining if the printer encounters an event while processing the print job; and
 - (iv) if it is determined that the print document has the at least one characteristic and that the printer has encountered the event while processing the job, then commanding a device to transmit a message to a pre-determined address.

16. (Previously Presented) The computer readable medium of claim 15 wherein the message is an e-mail message and commanding comprises commanding the device to transmit the message to an e-mail address.

17. (cancelled) The computer readable of claim 15, wherein the device is the printer.

18. (Previously Presented) The computer readable medium of claim 15, wherein the program of instructions comprises Web content.

19. (previously presented) A computing system, comprising:

- (a) means for receiving input from a user that specifies at least one print job criterion;
- (b) means for receiving a request from the user to submit a print job to a printer;
- (c) means for responding to the request by submitting the print job to the printer;
- (e) means for determining if the print job meets the at least one print job criterion;
- (e) means for determining if the printer encounters an event; and
- (f) means for transmitting a message to an address upon a determination that the print job meets the at least one print job criterion and that the printer has encountered the event.

20. (Previously Presented) The computing system of claim 19, further comprising:

- (e) means for receiving input from the user that specifies the address.

21. (previously presented) The computing system of claim 20, wherein the means for determining if the printer encounters an event comprises means for determining if the printer encounters a job failure.

22. (previously presented) The computing system of claim 21, wherein the means for transmitting a message comprises a means for transmitting an e-mail message to an e-mail address.

23. (previously presented) The computer system of claim 19, wherein the means for determining if the printer encounters an event comprises means for determining if the printer encounters a paper jam condition.

24. (previously presented) The computer system of claim 19, wherein the computer system includes a computer connected to the printer over a network.

Evidence Appendix

There is no extrinsic evidence to be considered in this Appeal.
Therefore, no evidence is presented in this Appendix.

Related Proceedings Appendix

There are no related proceedings to be considered in this Appeal. Therefore, no such proceedings are identified in this Appendix.